

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

190252-1740

Application Number

09/735,891

Filed

December 14, 2000

First Named Inventor

Kling

Art Unit

2157

Examiner

Gold, Avi M.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

/BAB/

Signature

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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Registration number if acting under 37 CFR 1.34

November 3, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Kling

Serial No.: 09/735,891

Filed: December 14, 2000

Confirmation No.: 5760

Group Art Unit: 2157

Examiner: Gold, Avi M.

Docket No.: 190252-1740

For: **System and Method for Sending Electronic Mail in a Client-Server Architecture**

**REMARKS IN SUPPORT OF
PRE-APPEAL BRIEF CONFERENCE**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicant submits the following remarks in support of a Request for a Pre-Appeal Brief Conference.

REMARKS

Applicant submits that the following clear legal deficiency exists in the rejection. Namely, the previous Office Action improperly uses the hindsight gleaned from the instant application to argue that the elements of the independent claims are obvious in view of the combination of the teachings of *Brown* and *Troen-Krasnow*. Applicant respectfully submits that one of ordinary skill in the art would not have combined the disclosed voicemail system of *Brown* into the email broadcasting system of *Troen-Krasnow*. Applicant respectfully submits that the voicemail messages generated in *Brown* are not normally broadcast for every component's access, and, therefore, it would not have been obvious for one of ordinary skill in the art to broadcast voice

mail messages. Therefore, Applicant respectfully submits that for this reason, one of ordinary skill in the art would not have combined the teachings of *Brown* and *Troen-Krasnow* without using hindsight gleaned from Applicant's disclosure. Therefore, the rejection is improper, the rejection should be withdrawn, and the claims allowed.

I. Rejections Under 35 U.S.C. §112

The Office Action rejects claims 1, 16, 29, and 34 under 35 U.S.C. §112, Second Paragraph as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action asserts that the newly amended portion seems to be opposite of what the specification does. Applicant respectfully submits that, according to at least one embodiment in the specification, the message is broadcast to everyone using the non-email broadcast text messaging software, but the content may be pertinent to only some of the recipients. In this embodiment, the recipients may determine whether the message is pertinent to them by examining the subject field of the text message. See *Specification*, page 12, line 21 – page 13, line 1. The Office Action argues that the cited “section discloses a client using subject based addressing technology to capture only those messages intended for it.” The Office Action alleges that “[c]learly, this shows a client can choose which messages to receive based on the subject, but does not teach a client sending a message where the subject field indicates to which client it is sent.” See Office Action, page 2.

First, claim 16 recites “the email application program interface is adapted to receive a text message using subject based addressing wherein text in a subject field of the text

message indicates an intended recipient." Applicant respectfully submits that claim 16 is clearly supported in the specification.

Second, if a receiver can determine which messages are intended for it based on the subject, the sender must have entered a subject by which the sender can make the determination. Therefore, since the specification discloses a receiving client using subject based addressing to capture the messages intended for it, one of ordinary skill in the art would understand that, the specification also infers that the sender uses subject based addressing to indicate the intended receiver of the messages. For at least this reason, Applicant respectfully submits that the rejection of claims 1, 16, 29, and 34 under § 112 should be withdrawn.

II. Rejections Under 35 U.S.C. §103(a)

The Office Action rejects independent claims 1, 16, 29, and 34 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Brown* (U.S. Patent No. 6,014,711) in view of *Troen-Krasnow, et al.* (U.S. Patent No. 6,442,250), further in view of Applicant's Admitted Prior Art. For at least the reasons set forth below, Applicant respectfully traverses these rejections.

Applicant respectfully submits that independent claim 1 is allowable for at least the reason that the combination of *Brown*, *Troen-Krasnow*, and *Applicant's Admitted Prior Art* does not disclose, teach, or suggest at least **broadcasting from the client a text message in a format of the non-email broadcast text messaging software using subject based addressing wherein text in a subject field of**

the text message indicates an intended recipient, and wherein the text message contains the electronic mail.

Even if, assuming for the sake of argument, *Brown* discloses a voicemail system for converting a voicemail message into an electronic format and addressing the message to the SMTP host, and *Troen-Krasnow* discloses that a message received by the recipient's equipment can include an email, Applicant respectfully submits that one of ordinary skill in the art would not have found it obvious to take the converted voicemail message taught by *Brown* and broadcast the converted voicemail message to every component on the network. Voicemail messages are not normally broadcast for every component's access, and, therefore, it would not have been obvious for one of ordinary skill in the art to broadcast voice mail messages. Therefore, the use of *Brown* in combination with *Troen-Krasnow* is improper and the rejection should be withdrawn for at least that reason.

The Office Action alleges that *Binns*, *Haaramo*, and *Wegner* offer examples of broadcasting converted voicemail messages. Applicant respectfully disagrees. Even if, assuming for the sake of argument *Binns* discloses a group message delivery system, *Binns* fails to disclose broadcasting to every device on the network. Instead, *Binns* discloses selecting a group, a step that is counterindicative of broadcasting. Even if, assuming for the sake of argument, *Haaramo* discloses voice based communicators between one terminal and a number of mobile terminals in a designated group, *Haaramo* fails to disclose broadcasting to every device on the network. Even if, assuming for the sake of argument *Wegner* discloses a message delivery system using

the most cost-effective route, *Wegner* fails to disclose broadcasting to every device on the network. Therefore, contrary to the assertions in the Office Action, Applicant respectfully submits that it is not obvious for one of ordinary skill in the art to broadcast a voicemail message to every device on the network.

Independent claims 16, 29 and 34 are allowable for similar reasons. For at least the reason that the independent claims are allowable over the cited references of record, the dependent claims (which depend from their respective independent claims) are allowable as a matter of law for at least the reason that the dependent claims contain all the features of their independent claims. Therefore, the rejection of the dependent claims should be withdrawn and the claims allowed.

CONCLUSION

For at least the reasons set forth above, favorable reconsideration and allowance, or the re-opening of prosecution on the merits of the present application and all pending claims are hereby courteously requested.

Respectfully submitted,

**THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.**

/BAB/

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